

Application No. 10/534,583

Reply to Office Action

*Applicants' Election*

Applicants elect, with traverse, the claims of Group X (claims 18, 20, 25, 27, and 31), drawn to a modified sarcosine oxidase having a lowered action on L-proline compared with one before modification, wherein amino acid residue 94 of SEQ ID NO: 1 is modified, for further prosecution.

*Discussion of Restriction Requirement*

The present application represents the U.S. national stage of International Patent Application No. PCT/JP03/14423. The Office Action alleges that the inventions defined by the claims of Groups I-XXI do not relate to a single general inventive concept under PCT Rule 13.2 because they lack the same "special technical feature."

The pending application contains several claims that are generic to and, thus, link two or more categories of subject matter set forth in the restriction requirement. For example, claims 1, 3, and 35 are directed to a modified sarcosine oxidase with improved stability in a liquid (or a gene encoding the sarcosine oxidase), but are not limited by way of the precise location of the modification. Accordingly, these claims encompass and, thus, link the subject matter of each of Groups I-IX and XII-XVIII. Similarly, claims 18, 20, and 42 are directed to a modified sarcosine oxidase with lowered action on L-proline (or a gene encoding the sarcosine oxidase), but are not limited by way of the precise location of the modification. Accordingly, these claims encompass and, thus, link the subject matter of each of Groups X, XI, and XIX-XXI.

However, the Office Action has not made the restriction requirement conditional upon the non-allowance of the genus claims, nor has the Office Action restricted the subject matter according to the genus claims. In effect, the restriction requirement as applied constitutes a rejection of the genus claims as encompassing more than one invention, which has been held to be improper. *See, e.g., In re Weber*, 580 F.2d 455, 458-59, 198 U.S.P.Q. 328, 331-332 (C.C.P.A. 1978).

Applicants are entitled to claim a genus. *Id.* Furthermore, the rules governing restriction requirements provide for such claims. For example, 37 C.F.R. § 1.141 provides that a reasonable number of species of an invention may be specifically claimed in different

Application No. 10/534,583

Reply to Office Action

claims of an application provided the application also includes an allowable claim generic to all of the claimed species and all of the claims to the species in excess of one are written in dependent form or otherwise include all of the limitations of the generic claim. Similarly, PCT Rule 13.4 states that "Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, *even where the features of any dependent claim could be considered as constituting in themselves an invention.*" The Administrative Instructions Under the PCT, at Annex B, further state:

Unity of Invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims.... If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

(Administrative Instructions Under the PCT, Annex B, Part I (copy located at appendix AI to MPEP, 8th ed., Rev. May 2004)). Thus, the genus (e.g., independent) claims of the application cannot properly be restricted to the subject matter of the species (e.g., dependent claims).

As the restriction requirement does not properly provide for the examination of the genus claims, it is improper and should be withdrawn.

Moreover, in view of the relationship of the subject matter defined by the pending claims to each other, i.e., all of the pending claims are directed to a sarcosine oxidase or gene encoding the same, a search for prior art with respect to the claims of Group X would likely uncover references that would be considered by the Examiner during the examination of the claims of Groups I-IX and XI-XXI, especially the claims of Groups X, XI, and XIX-XXI. As a result, the Examiner would incur no undue burden in examining all of the pending claims at the same time. See M.P.E.P. § 803 ("If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." (emphasis added)).

Application No. 10/534,583

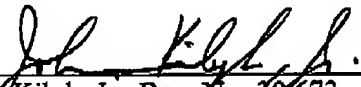
Reply to Office Action

For all of the foregoing reasons, Applicants request that all of the claims of Groups I-XXI be examined together or, at the least, the claims of Groups X, XI, and XIX-XXI be examined together.

*Conclusion*

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

  
\_\_\_\_\_  
John Kilyk, Jr., Reg. No. 30,673  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson Avenue  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: March 24, 2006